

EA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,502	08/05/2003	Sarah Nicole Coty	3255	8657

23618 7590 09/26/2005

CHASE LAW FIRM L.C
4400 COLLEGE BOULEVARD, SUITE 130
OVERLAND PARK, KS 66211

EXAMINER

BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,502

Applicant(s)

COTY, SARAH NICOLE

Examiner

Namrata Boveja

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 08/31/2005.
2. Claims 12-14 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 13 teaches a method, which includes the additional step of printing said coupons on said cover in a "partially-circling relationship." The claim does not enable one skilled in the art to determine how to **print** the said coupons in a "partially-circling relationship," since this was not defined in the specification. Figures 1 and 5 show the cover as applied to a handle. However, claim 13 does not recite putting the cover on the handle bar or applying the cover on the handle in a "partially-circling relationship," but instead recites, "**printing**" the said coupons in a "partially-circling relationship." Furthermore, Figure 8 illustrates does not illustrate how "**printing**" is done in a "partially-circling way."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 12 is rejected under U.S.C. 103(a) as being unpatentable over Duer
(Patent Number 5,820,142 hereinafter Duer) in view of official notice.

In reference to claim 12, Duer discloses a retail merchandising method for promoting goods and/or services and covering shopping cart handles at a retail business with a public entrance and shopping carts located in proximity thereto, which comprises steps of: providing a point of sale dispenser with four sides, a closed bottom, an open top and an interior open at said top (col. 19 lines 43-54, col. 2 lines 36-41, and Figure 72); providing a plurality of handle covers each having a generally tabular configuration with curved opposite ends, a passage extending longitudinally between and open at said ends and a slot extending longitudinally between and open at said ends with said passage being open at said slot (col. 3 lines 66-67, col. 4 lines 8-10 and lines 28-31, and Figure 1); fabricating said handle covers from disposable, recyclable paper or cardboard stock (col. 4 lines 28-21); applying to said handle covers multiple coupons corresponding to goods and/or services currently available for sale at said retail business pursuant to a discounted sale or promotion of same (col. 8 lines 40-46, col. 11 lines 63 to col. 12 lines 23, and Figures 22-26); nesting multiple covers into multiple cover stacks by inserting respective cover ends into adjacent cover passages (col. 16 lines 17-67); placing said cover stacks in said dispenser receivers with said covers extending upwardly above said stack upper end (col. 2 lines 36-41, col. 19 lines 43-54,

and Figure 72); installing said dispenser with said cover stacks placed therein in proximity to an entrance to said retail business whereat shopping carts are available to the customers (col. 2 lines 36-41); extracting said handle covers from said nested stacks of same and from said dispenser (col. 19 lines 43-54, col. 2 lines 36-41, and Figures 57, and 72); placing a first end of a respective handle cover over a shopping cart handle whereby said slot expands adjacent to said one end (col. 15 lines 4-7); receiving a part of said shopping cart handle in a part of said passage adjacent to said one end thereof (col. 15 lines 5-20); pressing said handle cover onto said shopping cart handle by expanding said slot and passing said shopping cart handle there through into said passage (col. 14 lines 39-52, and Figures 8, 44, and 57); disposing said handle covers (col. 12 lines 51-54 and col. 16 lines 26-31); and recycling said handle covers (col. 19 lines 55 to col. 20 lines 4, col. 17 lines 22 to col. 18 lines 35, and Figure 58). Duer does not recite providing said dispenser with multiple dividers positioned within said dispenser interior and forming a divider grid therein comprising multiple rows and columns of individual, vertically-oriented receivers each extending vertically from said dispenser bottom to said dispenser top and being open thereat; promoting goods and/or services available at said retail business with said dispenser by providing promotional indicia on at least one of said dispenser sides; and conducting a retail transaction at said retail business utilizing at least one of said coupons. Official notice is taken that it is old and well known to provide a dispenser with multiple dividers forming a grid with multiple rows and columns for displaying elongated products like a shopping cart handle cover and featuring promotions on the side of the of the said dispenser. For example,

Styrofoam swimming tubes sold at department stores are displayed in this manner with the price and/or a picture being depicted on the side of the cardboard dispenser. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of a dispenser with multiple dividers with promotions on the sides, since the dispenser would make it easy for the shoppers to reach to collect a handle cover (due to separation from each other and being held vertically) for placement on the shopping cart handle. Official notice is taken that it is old and well known to conduct a retail transaction at said retail business utilizing at least one of said coupons that are given at a store. For example, coupons that are placed on a shopping cart that indicate a discount for in store items have to be used at that particular store and may even have an expiration date for being valid on the day of the shopping trip itself to promote immediate use of the coupon. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include conducting a retail transaction at said retail business utilizing at least one of said coupons that are given at a store to promote the sale of specific items in the store.

5. In reference to claim 13, Duer discloses the further modified method which includes the additional step of printing said coupons on said cover in a partially-circling relationship (i.e. advertisements are placed on the top surface of the shopping cart handle bar) (col. 5 lines 16-27, col. 6 lines 47-50, col. 12 lines 13-17, and Figures 22, 24, 25, and 51).

6. In reference to claim 14, Duer discloses the further modified method which includes the additional steps of printing said coupons separately and releasably

Art Unit: 3622

adhering same to said cover, peeling said coupons from said cover and using same in connection with a retail transaction (col. 12 lines 4-23).

Response to Arguments

7. After careful review of Applicant's remarks/arguments filed on 08/31/2005, the examiner fully considered the arguments, but they are not persuasive.

First of all, the 112 Rejection is still maintained as shown above. Furthermore, the Examiner has legal authority to raise such issues and make such a rejection. Please, remember that the process steps of curling, and applying the handle cover in a partially encircling manner should be incorporated primarily in the body of the claims, which only recites printing the handle cover in a partially encircling manner. As stated in the argument, Fig. 8 shows a flat, pre-curling cover with the coupons. And, this printed cover is flat and therefore not partially encircling as claimed in claim 12.

8. Applicant argues that the Duer reference does not provide the motivation or teaching of such a method combining the claimed steps of providing shopping cart handles and dispensing same from point-of-purchase dispensers with additional promotional material printed thereon. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992). In this case, obviousness is established by combining Duer's teachings with the motivation found in the knowledge generally available to one of ordinary skill in the art. Specifically, it would be obvious to have a dispenser located at the point-of-purchase with additional material printed thereon as done with the sale of Styrofoam tubes used for swimming to keep the handle covers dispensed vertically, and to advertise the handle covers to the shoppers. Furthermore, Duer also teaches dispensing handle covers from a container or from a roll with or without a dispensing box (col. 10 lines 5-19 and Figure 10), and these dispensers could be located at the point-of-sale with or without a message letting the customers know that they can pick up handle covers at that location. Therefore, motivation can indeed be found in the prior art and in the knowledge generally available to one of ordinary skill in the art.

9. The Examiner wants to point out that dependent claims 13 and 14 depend directly from claim 12, and as such for the exact same reason set forth above, the Examiner rejection for these claims are maintained.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3622

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of contact


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

N.B.

September 16, 2005


RETTA YEHDEGA
PRIMARY EXAMINER